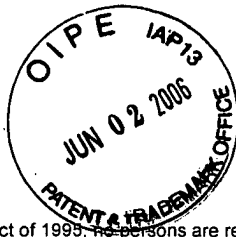


Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

08049.0765-00000

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on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Application Number

09/839,241

Filed

April 23, 2001

First Named Inventor

Robert Krause et al.

Art Unit

3621

Examiner

GREEN, Daniel L.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

☒

attorney or agent of record.

Registration number 43,515

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

William J. Brogan  
Signature

William J. Brogan

Typed or printed name

571-203-2700

Telephone number

June 2, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒

\*Total of 1 form is submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT  
Customer No.: 22,852  
Attorney Docket No. 08049.0765-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
)  
Robert Krause et al. ) Group Art Unit: 3621  
)  
Serial No.: 09/839,241 ) Examiner: GREENE, Daniel L.  
)  
Filed: April 23, 2001 )  
)  
For: Systems and Methods for ) Confirmation No.: 4011  
Providing Change of Address )  
Services Over a Network )

**Mail Stop AF**  
Commissioner for Patents  
P.O. Box 1450  
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Sir:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

In conjunction with a Notice of Appeal under 37 C.F.R. § 41.31, completed form PTO/SB/33, petition for a three-month extension of time, appeal fee payment, and extension of time fee payment filed concurrently herewith, Applicants respectfully request a pre-appeal brief review of this application.

**I. The Examiner Did Not Establish a *Prima Facie* Case of Obviousness in His 35 U.S.C. § 103(a) Rejection in view of *Goodman and Lockhart et al.***

Applicants respectfully submit that the Examiner failed to establish a *Prima Facie* case of obviousness in rejecting claims 4-6, 8-13, 55-56, 58, 60-66, 68-73, 115-116, 118, 120-122, 126-128, 130-135, 177-178, 180, and 182-184 under 35 U.S.C. § 103(a) in view of *Goodman and Lockhart et al.* for at least the reason that the references, taken alone or in combination, do not teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.

For example, independent claim 4 recites, *inter alia*, “processing the change of address information received from the service center electronically to enable the customer to receive mail addressed.” As explained on page 5 of the Reply filed

September 29, 2005, *Goodman and Lockhart et al.* fail to teach or suggest at least this element of claim 4. In the Final Office Action, the Examiner alleged that the following single sentence in the Abstract of *Goodman* discloses this element: “[a] service computer receives the change of address information from all the terminals, and in response thereto, the postal service and others desiring the change of address information are notified, ...”. (Final OA, p. 2). By citing this single sentence, the Examiner, without any support or basis, concluded that “the Examiner submits that the notification is done and the changes made electronically.” (*id*). This reasoning does not meet the standard for establishing a *Prima Facie* case of obviousness. The mere fact that *Goodman* describes electronic notification of the change of address information does not provide a showing that *Goodman* teaches or suggests electronic processing of that change of address information “to enable the customer to receive mail addressed to the old address of the customer at the new address of the customer.” *Goodman*’s system merely sends information to the postal service, it does not perform the recited electronic processing of the information. Nor does the Examiner’s reference to other portions of *Lockhart et al.* in the Final Office Action cure this deficiency. In the Final Office Action in which the Examiner reiterated the same rejections set forth in the first Office Action dated April 29, 2005, the Examiner alleged that Col. 2, lines 40-48, Col. 3, lines 40-45, Col. 6, lines 45-65, and Col. 10, lines 14-21 of *Goodman* disclose this feature. (Final OA, p. 4). However, none of the above portions cited by the Examiner disclose or suggest electronic processing of the change of address information “to enable the customer to receive mail addressed to the old address of the customer at the new address of the customer.”

Moreover, as explained on pages 5-6 of the Reply filed September 29, 2005, one of ordinary skill in the art would not have been motivated to combine the change of address terminals disclosed by *Goodman* with the information validation disclosed by *Lockhart et al.* because such modification would render the information validation of *Lockhart et al.* unsatisfactory for its intended purpose. See *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984); M.P.E.P. § 2143. *Lockhart et al.* rely on “credit card information and address data previously received from the user” (0091). Such information, however, would not exist in the public change of address terminals disclosed by

*Goodman*. In *Lockhart et al.*, repeat users establish accounts with password secured logins (0083) and address books (0086). In *Goodman*, by contrast, users access public change of address terminals (col. 2, lines 35-40) for the purpose of sending change of address notification during the first access. In such a system, the information validation of *Lockhart et al.* cannot work because there is no previously stored information in the public change of address terminal. Therefore, one of ordinary skill in the art would not have been motivated to include an information validation requirement using previously submitted information in the change of address terminals of *Goodman*, because such information does not exist.

**II. The Examiner Did Not Establish a *Prima Facie* Case of Obviousness in His 35 U.S.C. § 103(a) Rejection in View of *Goodman*, *Lockhart et al.*, and *Tsuei***

The Examiner also failed to establish a *Prima Facie* case of obviousness in rejecting claims 7, 14-20, 59, 67, 74-80, 119, 129, 136-142, and 181 under 35 U.S.C. § 103(a) in view of *Goodman* and *Lockhart et al.*, and *Tsuei* for at least the reason that the references, taken alone or in combination, do not teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.

Independent claim 14, for example, also recites, *inter alia*, electronic processing of the change of address information “to enable the customer to receive mail addressed to the old address of the customer at the new address of the customer.” As discussed above, *Goodman* and *Lockhart et al.*, taken alone or in combination, fail to teach or suggest at least this element in the claims. Nor does *Tsuei* disclose this element as admitted by the Examiner in the Final Office Action by not citing any portion of *Tsuei* with respect to this element. (Final OA, p. 11).

Further, claim 14 recites “sending the identification verification information to a third party for validating the identity of the customer.” As admitted by the Examiner, *Goodman* and *Lockhart et al.* fail to disclose this element. (Final OA, p. 12). The Examiner attempts to cure this deficiency with the disclosures of *Tsuei*. (Final OA, pp. 12-13).

However, as explained on page 7 of the September 29, 2005, Reply, one of ordinary skill in the art would not have been motivated to combine *Tsuei* with *Goodman*

and *Lockhart et al.* as suggested by the Examiner. First, as discussed above, one of ordinary skill in the art would not have been motivated to combine *Goodman* with *Lockhart et al.* Second, one of ordinary skill in the art would not have been motivated to combine *Tsuei* with *Goodman* and *Lockhart et al.* as suggested by the Examiner because the change of e-mail address system of *Tsuei* cannot work in the change of physical address system of *Goodman* and *Lockhart et al.* See *In re Gordon*, 733 F.2d at 902. *Tsuei* discloses an e-mail address management system ("EAMS") (Fig. 3; col. 6, lines 16-20). As taught by *Tsuei*, "e-mail is a computer-to-computer version of interoffice mail or the postal service." (col. 1, lines 25-26). An e-mail is sent from a computer, transmitted over a computer network, and ultimately received by a computer. (col. 1, lines 27-28). An e-mail address change may be registered with the EAMS by a recipient or by an internet service provider ("ISP"). (col. 10, lines 12-20). Once the e-mail address change is registered with the EAMS, the EAMS may send new e-mail address over the internet back to the sender ISP so that the sender ISP can forward the e-mail to the recipient's new e-mail address. (col. 10, lines 12-37). However, this change of email address system disclosed in *Tsuei* cannot work in changing physical address as taught by *Goodman* and *Lockhart et al.* Unlike emails, physical mails are physically (and not electronically) delivered to a recipient by a mailing authority such as the United States Postal Service, and are not sent over a computer network through ISPs. Therefore, even if the EAMS of *Tsuei* sent a new physical address over the internet back to the sender ISP, the sender ISP cannot forward a physical mail to the recipient's new physical address because ISPs are not involved in the delivery of a physical mail.

III. **35 U.S.C. § 103(a) Rejection of Claims 57, 117, and 179 in View of *Goodman*, *Lockhart et al.*, and *Salta* Must Be Withdrawn At Least by Reason of Their Incorporation of the Elements of Allowable Underlying Independent Claims.**

Applicants respectfully traverse the rejection of claims 57, 117, and 179 under 35 U.S.C. § 103(a) in view of *Goodman*, *Lockhart et al.*, and *Salta*. Claim 57 depends from claim 55; claim 117 depends from claim 115; and claim 179 depends from claim 177.

Claims 57, 117, and 179 are thus allowable at least by reason of their incorporation of the elements of allowable underlying independent claims.

**V. Conclusion**

Because the Examiner's 35 U.S.C. § 103(a) rejections of the claims are based on factual deficiencies and include clear errors that result in a failure to establish a *prima facie* case of obviousness, as demonstrated herein, Applicants are entitled to a pre-appeal brief review of the Final Office Action. Moreover, all of the claim rejections should be withdrawn.

Please grant any extensions of time required to enter this Request and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: June 2, 2006

By: William J. Brogan  
William J. Brogan  
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